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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,142	01/09/2001	Wilhelm Amberg	BBI-6026CPCN	6617

7590 05/30/2003

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EXAMINER
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CELSA, BENNETT M

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 05/30/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

File copy

## Office Action Summary

Application No.  
**09/757,142**

Applicant(s)  
**Amberg et al.**

Examiner  
**Bennett Celsa**

Art Unit  
**1639**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Apr 30, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

***Response to Amendment***

Applicant's amendment dated 4/30/03 in paper no. 16 is hereby acknowledged.

***Status of the Claims***

Claims 1-7 and 10 are pending and under consideration.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Withdrawn Objection (s) and/or Rejection (s)***

Applicant's amendment has overcome the indefinite rejection in items A. and B. of the previous office action.

The rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Haupt et al., U.S. Pat. No. 5,831,002 (11/98: filed 6/7/95 or earlier) is withdrawn since Applicant has provided evidence showing that the invention was owned by, or subject to an obligation of assignment to BASF Atkiengesellschaft at the time this invention was made. Accordingly, US Pat. No. 5,831,002 is disqualified as prior art through 35 U.S.C. 102(e), (f) or (g) in any rejection under 35 U.S.C. 103(a) in this application.

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***Outstanding Objection (s) and/or Rejection (s)***

2. Claims 1-7 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,103,698.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a composition that comprises a generic compound which encompasses species which overlap with the presently claimed invention and thus render the overlapping peptides obvious to one of ordinary skill in the art . For example, the patent claim 1 wherein all of the claim 1 variables are present as described and  $S=1$  ; and either  $U=1$  and  $T=0$  or  $U=0$  and  $T=1$ .

3. Claims 1-7 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,015,790.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims methods which utilize a composition that comprises a generic compound which encompasses species which overlap with the presently claimed invention and thus render the overlapping peptides obvious to one of ordinary skill in the art . For example, the patent claim 1 wherein all of the claim 1 variables are present as described and  $S=1$  ; and either  $U=1$  and  $T=0$  or  $U=0$  and  $T=1$ .

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4. Claims 1-7 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,831,002 .

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a generic which encompasses species which overlap with the presently claimed invention and thus render the overlapping peptides obvious to one of ordinary skill in the art. For example, the patent claim 1 wherein R1 is alkyl; R2 is hydrogen; or R1- N- R2 come together to form a 5-6 member nitrogen containing ring; X is alkyl; A,B,D,E are as presently claimed; s is 1; t is 0; u is 0 or 1; and K corresponds to an amine moiety R5-N-R6 wherein R5 and R6 are independently hydrogen or unsubstituted or substituted alkyl including ethers or R5 and R6 form a ringed structure for example a four ringed heterocycle containing N in the ring; or a six membered ring containing N and O. Additionally, for further selections of K values columns 55-57 could be selected including Xkv, Xky, Xld, Xlf, Xll, Xlm, Xls, Xlt, Xlu, Xma (see also third and second to last substituent of K substituent in claim 4 which encompasses K values within the scope of the presently claimed invention.)

5. Claims 1-7 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,965,700.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a method which encompasses species which are within the scope of the presently claimed invention and thus render the overlapping peptides obvious to one

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of ordinary skill in the art which would be motivated to make such overlapping peptides to achieve antineoplastic compounds.

***Discussion***

Applicant will consider filing a terminal disclaimer (s) addressing the above double patenting rejections in due course.

Accordingly, the above-identified double patenting rejection(s) are hereby maintained.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)  
May 29, 2003

BENNETT CELSA  
PRIMARY EXAMINER

